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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,655	05/08/2001	Ephraim Zehavi	QCPA181ACAC	4391

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EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,655

Applicant(s)

LAROCCA ET AL.

Examiner

Phuongchau Ba Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-19-02 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second "means for receiving said second packet and for modulating said traffic packet in accordance with said second orthogonal code sequence of said plurality of orthogonal code sequence" {claim 11, lines 15-18; claim 16, lines 15-18; claim 21, lines 16-21} must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 7-10, 12-15, 19-20, 22-24, 26-28 are objected to because of the following informalities: claim 6 is a system claim, thus claim 7-10 (line 1) "the apparatus of claim 6" should be changed to --the system of claim 6---. Likewise, claims 12-15, 22-24, 26-28 have the same problem as claims 7-10. Claim 16 is a method claim, thus claims 19-20 (line 1) "the apparatus of claim" should be changed to --the method of claim---. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter is "means for receiving said second packet and for modulating said traffic packet in accordance with a second orthogonal code sequence of said plurality of orthogonal code sequences and having a first output for providing said orthogonal code modulated traffic packet"(claim 11, lines 15-18) and "a second modulator having an input for receiving said second packet and for modulating said traffic packet in accordance with a second orthogonal code sequence of said plurality of orthogonal code sequences and having a first output for providing said orthogonal code modulated traffic packet"(claim 16, lines 15-18; claim 21, lines 16-21). Applicant is directed to specification page 10 on paragraph 0038 wherein if the packet requires use of an overflow channel for transmission, the demultiplexer 56 splits the packet into two portions; and specification page 11 on paragraph 0042 wherein the first half is provided to element 58 of first modulator means and the second half is provided to element 60 of second modulator means; see also figure 5. Therefore, the "means for receiving said second packet and for modulating said traffic packet in accordance with a second orthogonal code sequence of said plurality of orthogonal code sequences and having a first output for providing said orthogonal code modulated traffic packet" is not supported by the specification.

Claims 12-15, 17-20, and 22-24 are rejected because they are dependent claims to claims 11, 16 and 21.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11-24 provides for the use of method for transmitting, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced and claim 16 recites elements (i.e. channel packetizer, first modulator, first PN modulator, second modulator, second PN modulator, transmitter---apparatus claim type, emphasis added). Moreover, dependent claims 17-18 of claim 16 are the method claims and dependent claims 19-20 of claim 16 are the apparatus claims.

7. Claim 11 recites the limitation "said second packet" in line 15, and "said orthogonal code modulated overflow packet" in line 19. Claim 16 (lines 15-20) and claim 21 (lines 16-21) also have the same problem as claim 11. There is insufficient antecedent basis for this limitation in the claim.

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Also, claim 11 is vague because it is not seen how the "orthogonal code modulated overflow packet"(line 19) being generated. Claims 16 (lines 15-20) and 21 (lines 16-21) also have the same problem as claim 11.

Claims 12-15, 17-20, and 22-24 are rejected because they are dependent claims to claims 11, 16 and 21.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 6-10, 11, 21 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5, 11 of prior U.S. Patent No. 5,777,990. This is a double patenting rejection.

10. Claims 25-28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2, 6-7 of prior U.S. Patent No. 6,292,471. This is a double patenting rejection.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 12-15, 16-20, 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5 of U.S.

Patent No. 5,777,990. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims 12-15 & 17-20 merely broaden the patented claims 2-5, 11 by redrafting the dependency of patented claims 2-5 on patented claim 11 which is a system for transmitting variable rate packets of data symbols comprising a channel packetizer, a first modulator, a first PN modulator, a second modulator, a second PN modulator, a transmitter instead of patented claim 1 which also is a system for transmitting variable rate packets of data symbols comprising channel packetizer means, first modulator means having a PN modulator, second modulator means having a PN modulator, a transmitter. Therefore, it would have been obvious to a skilled artisan to add the patented dependent claims 2-5 (as now claims 12-15, 22-24) as dependent claims to patented claim 11 and the motivation being to

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provide another non-identical claims set of claims 1-5. Also, claims 17-20 are method claim, therefore, it would have been obvious to a skilled artisan to implement a teaching of an element's function in a method claim and the motivation being to provide a software implementation (e.g. software programming) of claimed elements (i.e., channel packetizer, first modulator, first PN modulator...etc. in patented claims 1 and 11) for easing the upgrade of elements.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is

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703-305-0093. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

PN

Phuongchau Ba Nguyen
Examiner
Art Unit 2665

May 2, 2002



HUY D. VU
PRIMARY EXAMINER